

**REMARKS**

By this reply, Applicant amends claims 1 and 9, and adds new claims 55-60. Accordingly, claims 1, 5-37, and 55-60 are pending in this application. Of those pending claims, claims 9-13 and 17-37 were previously withdrawn. No new matter has been added with this reply.

In the Final Office Action, claims 1 and 5-8 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,865,728 to Moll et al. ("Moll"); claims 1, 5-8 and 14 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,488,877 to Klein et al. ("Klein"); and claims 15 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Klein.

**Rejections Under 35 U.S.C. § 102(b)**

In light of the amendment to independent claim 1, Applicant requests withdrawal of the rejections under 35 U.S.C. § 102(b) set forth on page 3 of the Office Action. Amended independent claim 1 now recites, *inter alia*, "an insertion tool for inserting or assisting the insertion of or deployment of the retracting member in the wound opening, wherein the insertion tool includes a groove for receiving the distal portion of the retractor for mounting the retractor to the insertion tool, and at least a portion of the insertion tool is configured to penetrate the wound opening."

Moll fails to teach or suggest each of the limitations recited in amended independent claim 1. Moll discloses a device 1 including a main envelope 6, a main inflation tube 16 sealed into the main envelope 6, and an inflation tube shield 61. *See* Moll, column 8, lines 65-67; column 9, lines 5 and 6; and column 10, lines 12-15; and FIGS. 1-4D. When main envelope 6 is inflated, its expansion displaces a bowel B. *See*

*Id.* at column 12, lines 33-36; and FIGS. 1-4D. Moll also discloses use of a flexible sheath 43 that page 3 of the Office Action asserts is a gripping or insertion tool. However, Moll clearly states that flexible sheath 43 is "installed after the retraction device 1 has been deployed in the body." *See Id.* at column 19, lines 46 and 47. Since flexible sheath 43 is installed after insertion or deployment of retraction device 1, flexible sheath 43 does not insert or assist the insertion of or deployment of main envelope 6 of retraction device 1. Thus, Moll fails to teach or suggest "an insertion tool for inserting or assisting the insertion of or deployment of the retracting member in the wound opening, wherein the insertion tool includes a groove for receiving the distal portion of the retractor for mounting the retractor to the insertion tool, and at least a portion of the insertion tool is configured to penetrate the wound opening," as recited in amended independent claim 1. Accordingly, Moll fails to anticipate amended independent claim 1.

Klein also fails to teach or suggest each of the limitations recited in amended independent claim 1. Klein discloses an implant including a rigid tubular device 10 and attached flexible sleeve member 12, with rigid tubular device 10 including a ridge 46 allowing rigid tubular device 10 to be held by means of a forceps during implantation and needle change operations. *See Klein*, column 2, lines 60-62; and column 4, lines 5-8. Klein states that "[a] suitable forceps tool for gripping ridge 44 is described in co-pending application, Serial No. 209,058, filed 11/21/80, the disclosure of which is incorporated herein by reference." *Id.* at column 4, lines 8-10. The co-pending application being referred to in Klein is U.S. Patent No. 4,776,843 to Martinez et al. ("Martinez"). In Martinez, a stem clamping forceps 100 is depicted that includes arms

101 and 102 having grooves 105 and 106 for engaging a flange 42 of a stem 11. See Martinez, column 8, lines 50-61; and FIGS 14-18. However, stem clamping forceps 100 in no way penetrates a wound opening. Thus, since stem clamping forceps 100 does not penetrate a wound opening, Klein and Martinez fail to teach or suggest "an insertion tool for inserting or assisting the insertion of or deployment of the retracting member in the wound opening, wherein the insertion tool includes a groove for receiving the distal portion of the retractor for mounting the retractor to the insertion tool, and at least a portion of the insertion tool is configured to penetrate the wound opening," as recited in amended independent claim 1. Accordingly, the references fail to anticipate amended independent claim 1.

Claims 5-8 and 14 each depend from amended independent claim 1, and are allowable for at least the reasons stated above that amended independent claim 1 is allowable. In addition, each of the dependent claims recites unique combinations that are neither taught nor suggested by the cited art, and therefore each is also separately patentable.

**Rejection Under 35 U.S.C. § 103(a)**

In light of the amendment to independent claim 1, Applicant requests withdrawal of the rejection of claims 15 and 16 under 35 U.S.C. § 103(a) over Klein. As discussed above, Klein fails to teach or suggest each of the limitations in amended independent claim 1, from which claims 15 and 16 depend. Even if stem clamping forceps 100 of Klein could be modified with respect to its dimensions in the manner suggested on page 4 of the Office Action, such a modification would not remedy the deficiencies of Klein set forth in the discussion of amended independent claim 1. Therefore, claims 15 and 16

are allowable at least for the same reasons that amended independent claim 1 is allowable.

### **Request for Rejoinder**

Applicant requests that previously withdrawn claims 9-13 and 17-37 be rejoined with the elected claims in this application. Claims 9-13 and 17-37 all depend either directly or indirectly from amended independent claim 1, and thus, are allowable for at least the same reasons that amended independent claim 1 is allowable. In addition, each of these withdrawn dependent claims recites unique combinations that are neither taught nor suggested by the cited art, and therefore each is also separately patentable.

### **New Claims**

New independent claim 55 recites, *inter alia*, “an insertion tool for inserting or assisting the insertion of or deployment of the distal portion through the wound opening, wherein the insertion tool includes a groove for receiving the distal portion of the retractor for mounting the retractor to the insertion tool.” Moll does not anticipate new independent claim 55 for at least the same reasons discussed above with respect to amended independent claim 1. Klein does not anticipate new independent claim 55 because the stem clamping forceps 100 of Martinez do not insert ridges 44 or 46 through the wound opening. See Klein, column 4, lines 5-11, and FIG. 1; and also Martinez, column 8, lines 51-61, and FIGS. 14-18. Support for new independent claim 55 can be found at least in FIGS. 43-46 of Applicant’s drawings.

Claims 56 and 57 depend from new independent claim 55, and are therefore allowable for at least the same reasons that new independent claim 55 is allowable. In

addition, the dependent claims recite unique combinations that are neither taught nor suggested by the cited art, and therefore are also separately patentable.

New independent claim 58 recites, *inter alia*, "an insertion tool for inserting or assisting the insertion of or deployment of the retracting member in the wound opening, wherein the insertion tool includes an opening for completely receiving at least a portion of the distal portion of the retractor for mounting the retractor to the insertion tool, and a blunted end for insertion into the wound opening." Moll does not anticipate new independent claim 58 for at least the same reasons discussed above with respect to amended independent claim 1. Klein does not anticipate new independent claim 58 because stem clamping forceps 100 of Martinez do not include an opening for completely receiving ridges 44 or 46. See Klein, column 4, lines 5-11, and FIG. 1; and also Martinez, column 8, lines 51-61, and FIGS. 14-18. Support for new independent claim 55 can be found at least in FIGS. 43-46 of Applicant's drawings. For example, FIG. 43 shows an opening between two distally extending portions of tool 120, with a portion of distal ring 91 being completely received in the opening such that no part of the portion of distal ring 91 extends outside of the opening.

Claims 59 and 60 depend from new independent claim 58, and are therefore allowable for at least the same reasons that new independent claim 58 is allowable. In addition, the dependent claims recite unique combinations that are neither taught nor suggested by the cited art, and therefore are also separately patentable.

In view of the foregoing amendments and remarks, Applicant submits that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the Examiner's

reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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